

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 60374.0040US02/CPOL 968020									
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number 10/010,270	Filed December 6, 2001									
	First Named Inventor Harold J. Plourde Jr.										
	Art Unit 2421	Examiner Hoang Vu A Nguyen Ba									
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding-bottom: 10px;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; vertical-align: top; padding-bottom: 10px;">/David Rodack/ _____ Signature</td></tr><tr><td style="vertical-align: top; padding-bottom: 10px;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="vertical-align: top; padding-bottom: 10px;">David Rodack _____ Typed or printed name</td></tr><tr><td style="vertical-align: top; padding-bottom: 10px;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number 47,034</td><td style="vertical-align: top; padding-bottom: 10px;">404.954.5049 _____ Telephone number</td></tr><tr><td style="vertical-align: top; padding-bottom: 10px;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="vertical-align: top; padding-bottom: 10px;">August 17, 2010 _____ Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.	/David Rodack/ _____ Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	David Rodack _____ Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number 47,034	404.954.5049 _____ Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	August 17, 2010 _____ Date
<input type="checkbox"/> applicant/inventor.	/David Rodack/ _____ Signature										
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	David Rodack _____ Typed or printed name										
<input checked="" type="checkbox"/> attorney or agent of record. Registration number 47,034	404.954.5049 _____ Telephone number										
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	August 17, 2010 _____ Date										
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.											

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:
Harold J. Plourde Jr.

Serial No.:
10/010,270

Filed:
December 6, 2001

For:
**Controlling Substantially Constant Buffer
 Capacity For Personal Video Recording
 With Consistent User Interface Of Available
 Disk Space**

Confirmation No.:
5626

Group Art Unit:
2421

Examiner:
Hoang Vu A Nguyen Ba

Docket No.:
60374.0040US02/CPOL 968020

**REMARKS IN SUPPORT OF
 PRE-APPEAL BRIEF CONFERENCE**

Mail Stop AF
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

Applicants submit the following remarks in support of a request for a pre-Appeal Brief Conference. Claims 1-3 and 5-47 are currently pending and subject to a final rejection per the final Office Action mailed on March 17, 2010. Of particular relevance to the present response, the final Office Action rejected independent claim 1 under 35 U.S.C. §103(a), and independent claim 24 under 35 U.S.C. §102(e). That is, independent claim 1 has been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent Application Publication No. 2002/0040475 to *Yap et al.* ("Yap"), and independent claims 24 has been rejected as allegedly anticipated by *Yap*. The final Office Action rejected other claims using at least the aforementioned grounds for rejection and *Yap*, but for purposes of the present response, Applicants address the rejection to claims 1 and 24 for purposes of pointing out errors of fact and law. Applicants respectfully traverse the rejections, and respectfully submit that there exist clear cases of error, supported by the evidence in the record, in these rejections.

REMARKS1. Independent claim 1 - 35 U.S.C. §103(a)

As set forth on page 18 in the response to non-final Office Action (herein, “non-final OA response”) dated January 6, 2010, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and hence submit that the rejection is based at least on an error at law. For instance, the rejection does not disclose, teach, or suggest a buffer space residing in a hard disk where there is a visual indication of available free space, the ***indication independent of the buffer space***. The final Office Action acknowledges (page 7) that “Yap does not explicitly disclose that the buffer space is in the hard disk,” yet alleges in part the following (page 7):

However, the decision of whether to locate the SDRAM 315 with buffer space 316 inside or separate from the hard disk HDD 320 (e.g., FIGs. 6, 8-9) is a matter of design choice, one of which may be the choice and the advantage of integrating the SDRAM with the HDD to help improve the compactness and reliability of the design.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Yap by integrating the SDRAM with the HDD for the purpose discussed above.

As a preliminary note, the final Office Action (page 7) references figures 21a-e, 22a-c, and 23a-c for the visual indication of free space features. As noted on pages 18-19 of the non-final OA response, these figures are directed to the HDD 320, not SDRAM. Assuming *arguendo* that the SDRAM 315 can be incorporated into the HDD 320, then a *prima facie* case of obviousness still cannot be established (and hence an error in law) since it either (1) could not then be reasonably alleged that the indication of available free space is ***independent of the buffer space*** (in view of their alleged consolidation), or in the alternative, (2) it cannot be reasonably alleged that Yap is modified in a predictable manner (e.g., see page 3 of the final Office Action) as to whether buffer space and the disk space that allegedly encompasses the buffer space are independent in any ensuing free space indication. That is – how is the free space indication handled in view of any consolidation? There is no evidence or support for a buffer-independent indication after consolidation.

As a further error, it is noted that the contentions (page 7, final Office Action) that the SDRAM 315 can be integrated into the HDD 320 has not been established by the evidence on the record. The reference to para. 0254 of Yap on page 3 of the final Office Action merely discloses that the SDRAM can be consolidated into “a single SDRAM or other memory device,” not that ***the*** SDRAM 315 with buffer space 316 can be consolidated ***specifically in the HDD***

320. It is further noted that claim 1 of *Yap* draws a distinction between a “memory device” like SDRAM and a “storage device” like the HDD (see claim 15). Even assuming *arguendo* that buffer space can be integrated in a hard disk (see, e.g., page 3 of the final Office Action and “well-known” allegation), that still does not mean that free space indication has a buffer space/ hard disk space independence.

The final Office Action further alleges in part (page 3) the following:

In response to 2) i), it is respectfully noted that the features of having the buffer space being housed in the hard disk is, as discussed in the OA, deemed obvious because design incentives (or choices) or other market forces (more compact device) could have prompted one of ordinary skill in the art to modify *Yap* in a predictable manner (maintaining same inputs, same functions and same output results) to result in the claimed invention for compact design purposes. In *Dann v. Johnston*, the Court held that “[t]he gap between the prior art and respondent’s system is simply not so great as to render the system nonobvious to one reasonably skilled in the art.”

As set forth in the non-final OA response (pages 19-21), the allegation of design choice is not consistent with the teachings of *Yap*. For instance, the inventor in *Yap* appeared to make a conscious decision (based on the extensive citations to the process utilizing both) in *Yap* to use both the HDD and SDRAM as separate devices for downloading content, the latter (SDRAM) apparently serving to facilitate the control by host processor in routing content to the HDD 320 (see, e.g., paragraph [0176]). Again, even assuming *arguendo* the buffer space of SDRAM 315 can be integrated in the HDD 320, evidence of which is not established, that does not address the free space indication and its independence from the buffer space, but rather, suggests consolidation in a single GUI, and hence the rejection is based on an error in law in that a *prima facie* case of obviousness has not been established.

Further, as set forth in the non-final OA response (id), Applicants respectfully note that *Yap* does indeed appear to disclose a buffering mechanism in the HDD 320, and in particular, in the pause mechanism (for live broadcast) (see, e.g., para 0348). Further, as indicated in the non-final OA response (id), *Yap* also discloses in paragraph [0158] that the capacity appears to be distributed among the permanent recording space and the temporary space (pause function). Paragraph [0158] of *Yap* is reproduced in part discloses (emphasis added) that the “...HDD 320 may have a capacity of at least about 25 Gbytes, where preferably about at least 20 Gbytes is available for various recording applications, and the remainder flexibly allocated for pause applications in architecture 700.” Given the fact that the pause space allocation in the HDD 320 is “flexibly allocated,” and the 25 Gbytes capacity includes the 5 and 20 Gbyte portions, it is reasonable to assume that the free space indication includes both portions (are combined in, say, figure 21 of *Yap*) as well. If not combined, then the flexible allotment of 5 Gbytes of the

total 25 Gbytes does not match up visually (from a percentage perspective) to the figures (e.g., Figures 21a-c of *Yap*, which for instance, shows 100% as being less than the capacity represented by the full gauge). For instance, if the capacity is 25 Gbytes from which 5 Gbytes is set off for pause, then it makes no sense to consider the 20 Gbytes to be equivalent to the 0-100% and equate the pause to that area outside of the 0-100%, since 5 + 20 make-up the capacity. If the entire gauge is 25, then 20 + 5 portions would also lend support to a visual indication that includes both buffered and permanent space (and not independent).

Further, the rejection is based on an error in fact. The final Office Action (pages 2-3, emphasis added) further alleges in part the following:

Furthermore, it should be noted that it is commonly known that the size of buffer space is predetermined (8 MB, 16, MB, etc.) and is always less than that of a hard disk (e.g., 20 GB, etc.) because the function of the buffer space is to temporarily store incoming data while the outgoing data is written to the hard disk which operates slower than the buffer space (RAM). Since this data transfer is transparent and irrelevant to a viewer for the assessment of available free space for recording programs which are to be stored on a permanent storage device such as a hard disk, there is no need to be[sic] monitor the available free space in a buffer space.

It is respectfully considered that the claim element “such that the indication is independent of the buffer space” is included in the claim to merely avoid the teachings of the prior art because this feature is not believed to be an inventive novelty.

Applicants respectfully submit that the underlined contentions are contradicted by the evidence of record, and hence constitute an error in fact. For instance, the buffer space independence feature is indeed an intended, original (and not an “add-on” in view of the cited art) feature of the claims, as witnessed by its presence in the original filed claims (see, e.g., claim 1 as originally filed). Further, given that buffer space capacity is described on page 28 of the filed application as holding a considerable amount of content (e.g., 3-4 hours worth of content), and given that the buffered content is not transparent to the user as disclosed in Figures 20-22, the allegation of irrelevance is belied by Applicants’ disclosure that buffered content is significant. Even the art of record (e.g., *Yap*) recognizes that buffered content is neither transparent nor irrelevant to the viewer, as noted by the reference to buffered live broadcast in the pause mode (see, e.g., para 0348, *Yap*). For at least the reasons that the rejection is based on errors in fact and law, Applicants respectfully request that the final rejection to claim 1 be withdrawn and the case re-opened for prosecution.

2. Independent claim 24- 35 U.S.C. §102(e)

The final Office Action (page 12) equates the buffer space to the SDRAM 315. However, the storage device, referenced in the preamble of claim 24 and in the body of the claim, includes a hard disk (As noted by the preamble). The SDRAM 315 of *Yap* does not. Claim 24 also requires buffering media content instances into buffer space of the storage device, and providing a visual indication of an amount of available free space of the storage device, such that the indication is independent of the buffer space. The final Office Action (page 5) further alleges that based on para. 0254 of *Yap*, “*Yap* indicates that buffer space SDRAM 315 can be consolidated into other memory device.” The final Office Action (page 5) further continues, alleging that “this can be interpreted that SDRAM 315 can be part of HDD 320 which is considered to[sic] a memory device.” Similar to the arguments set forth above, (1) assuming the SDRAM 315 could be integrated into the HDD 320, then Applicants respectfully submit that such an allegation either favors a consolidated gas disk gauge (as shown in Figure 21a-b of *Yap*), or in the alternative, fails to lead to predictability as to the buffer-independent free space indication, and (2) there is no evidence that the SDRAM 315 can be integrated into the HDD 320 (though each type of memory device and storage device may be embodied in other forms). Accordingly, as to (1) a prima facie case of obviousness has not been established with regard to the visual indication, buffer independence feature, resulting in an error in law, and as to (2) there is an error in fact. For at least these reasons, Applicants respectfully request that the rejection to claim 24 be withdrawn and the case re-opened for prosecution.

CONCLUSION

Favorable reconsideration and allowance, or the re-opening of prosecution on the merits, of the present application is hereby courteously requested.

Respectfully submitted,

Date: August 17, 2010

By: /David Rodack/
David Rodack, Reg. No. 47,034

Merchant & Gould
P.O. Box 2903
Minneapolis, Minnesota 55402-9946
Telephone: 404.954.5049

